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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/562,018

06/30/2006

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EXAMINER

OH, TAYLOR V

ART UNIT

PAPER NUMBER

1625

MAIL DATE

DELIVERY MODE

09/10/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/562,018	Applicant(s) YASUHARA ET AL.	
	Examiner Taylor Victor Oh	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 60 is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/09;9/08;7/07;12/05</u> . | 6) <input type="checkbox"/> Other: _____ |

The Status of Claims:

Claims 1-60 are pending.

Claims 1-59 are rejected.

Claim 60 is allowable.

DETAILED ACTION

1. Claims 1-60 are under consideration in this Office Action.

Priority

2. It is noted that this application is a 371 of PCT/JP02/12409 (11/28/02), which has foreign priority documents, Japan 2001-363336 (11/28/2001) and Japan 2002-248888 (08/28/2002).

Drawings

3. None.

Election/Restriction

Applicant's election with traverse of Group I (claims 1-60) on 7/29/09 is acknowledged.

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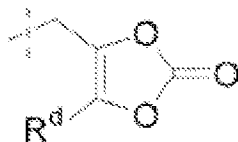
Claims 1-59(a heterocyclic or heteroaromatic compound of formula I) are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected groups II, there being no allowable generic or linking claim.

Claim Objections

Claims 1-59 are objected to because of the following informalities:

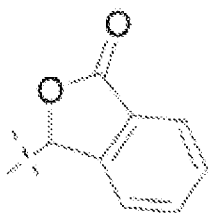
In the claims, the phrases of the heterocyclic or heteroaromatic compound of formula I are present in the followings:

R^1 and R^2 are identical or different, and each represents



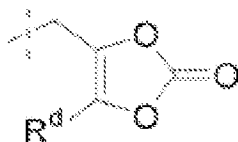
a 4-morpholinylC₁₋₁₆alkyl group.

[i]



[ii]

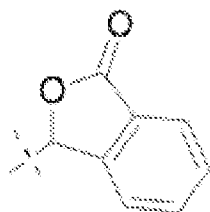
in the case where either R^1 or R^2 represents



a 4-morpholinylC₁₋₁₆alkyl group.

[i]

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(iii)

Y represents $-\text{OCHR}^3\text{R}^4$, $-\text{SR}^3$, $-\text{S(O)}_n\text{R}^5$, $-\text{SCHR}^3\text{R}^4$, $-\text{S(O)}_n\text{CHR}^3\text{R}^4$, $-\text{NHCOR}^3$, $-\text{NHCOR}^5$, $-\text{NHCOR}^3$ or $-\text{OCOR}^5$ (wherein R^3 , R^4 , R^5 and R^6 are identical or different, and each represents heteroaromatic group, R^7 represents heteroaromatic group).

$-\text{N}(\text{CHR}^3\text{R}^4)(\text{CHR}^3\text{R}^4)$, $-\text{NHCOR}^3$ or $-\text{OCOR}^5$ (wherein R^3 , R^4 , R^5 and R^6 are identical or different, and each represents heteroaromatic group, R^7 represents heteroaromatic group).

These limitations should be removed from the claims since they belonged to the Group II of the claimed invention.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1-58, the phrase “2-amino-bicyclo[3.1.0] hexane-2,6-dicarboxylic ester derivative” is recited. This term “derivative” is vague and indefinite because the

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specification does not elaborate what is meant by the term “derivative” . Appropriate correction is required.

In claim 59, the term “ drag” is recited. This expression is vague and indefinite because it may be mis-spelled or it may mean a different meaning in the claim.

An appropriate correction is required.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-59 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for making salts of the claimed compounds, does not reasonably provide enablement for making solvates and hydrates of the claimed compounds. The specification does not enable any person skilled in the art of synthetic organic chemistry to make the invention commensurate in scope with these claims. “The factors to be considered [in making an enablement rejection] have been summarized as a) the quantity of experimentation necessary, b) the amount of direction or guidance presented, c) the presence or absence of working examples, d) the nature of the invention, e) the state of the prior art, f) the relative skill of those in that art, g) the predictability or unpredictability of the art, h) and the breadth of the claims”, *In re Rainer*, 146 USPQ 218 (1965); *In re Colianni*, 195 USPQ 150, *Ex parte Formal*, 230 USPQ 546. In the present case the important factors leading to a conclusion of undue

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experimentation are the absence of any working example of a formed solvate, the lack of predictability in the art, and the broad scope of the claims.

c) There is no working example of any hydrate or solvate formed. The claims are drawn to solvates, yet the numerous examples presented all failed to produce a solvate. These cannot be simply willed into existence. As was stated in *Morton International Inc. v. Cardinal Chemical Co.*, 28 USPQ2d 1190 "The specification purports to teach, with over fifty examples, the preparation of the claimed compounds with the required connectivity. However ... there is no evidence that such compounds exist... the examples of the '881 patent do not produce the postulated compounds... there is ... no evidence that such compounds even exist." The same circumstance appears to be true here. There is no evidence that solvates of these compounds actually exist; if they did, they would have formed. Hence, applicants must show that solvates can be made, or limit the claims accordingly.

g) The state of the art is that is not predictable whether solvates will form or what their composition will be. In the language of the physical chemist, a solvate of organic molecule is an interstitial solid solution. This phrase is defined in the second paragraph on page 358 of West (Solid State Chemistry). West, Anthony R., "Solid State Chemistry and its Applications, Wiley, New York, 1988, pages 358 & 365. The solvent molecule is a species introduced into the crystal and no part of the organic host molecule is left out or replaced. In the first paragraph on page 365, West (Solid State Chemistry) says, "it is not usually possible to predict whether solid solutions will form, or if they do form what is their compositional extent". Thus, in the absence of experimentation one cannot

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predict if a particular solvent will solvate any particular crystal. One cannot predict the stoichiometry of the formed solvate, i.e. if one, two, or a half a molecule of solvent added per molecule of host. In the same paragraph on page 365 West (Solid State Chemistry) explains that it is possible to make meta-stable non-equilibrium solvates, further clouding what Applicants mean by the word solvate. Compared with polymorphs, there is an additional degree of freedom to solvates, which means a different solvent or even the moisture of the air that might change the stable region of the solvate.

h) The breadth of the claims includes all of the hundreds of thousands of compounds of formula I as well as the presently unknown list of solvents embraced by the term "solvate". Thus, the scope is broad.

MPEP 2164.01(a) states, "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)." That conclusion is clearly justified here. Thus, undue experimentation will be required to practice Applicants' invention.

Claim Rejections - 35 USC § 102

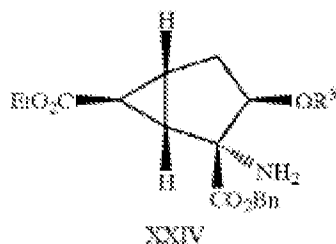
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-59 are rejected under 35 U.S.C. 102(b) as being anticipated clearly by Adam et al (US 6,107,342).

Adam et al discloses the followings (see col. 13 ,lines 30-53):



According to scheme 3 the O-alkylated compounds of general formula I, wherein R³ is lower alkyl (I-7 and I-8), lower alkenyl (I-9) or benzyl (I-10) can be prepared from compounds of the general formulae XXIII (XXIII-1 with R³=CH₃; XXIII-2 with R³=allyl; and XXIII-3 with R³=benzyl;) and XXIV (XXIV-1 with R³=CH₃; XXIV-2 with R³=allyl; and XXIV-3 with R³=benzyl;) by the methods described above for the preparation of compound I-A.

EXAMPLE 26

(1S,2R,3R,5R,6S)-3-Allyloxy-2-amino-bicyclo
[3.1.0]hexane-2,6-dicarboxylic acid 2-benzyl ester
6-ethyl ester (XXIV-2)

EXAMPLE 27

(1S,2R,3R,5R,6S) -2-Amino-3-benzyloxy-bicyclo
[3.1.0]hexane-2,6-dicarboxylic acid 2-benzyl ester
6-ethyl ester (XXIV-3)

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(see col. 28, lines 17-61). This is identical with the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Taylor Victor Oh, MSD,LAC
Primary Examiner
Art Unit :1625

/Taylor Victor Oh/
Primary Examiner, Art Unit 1625
9/09/09

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